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## REMARKS

The Examiner notes that not all amendments made to the specification in the preliminary amendment filed on April 16, 2002 have been entered because the paragraph numbers of the amendment do not correspond to the numbers in the specification. The undersigned has reviewed his file and the numbers appear to correspond. The undersigned therefore must respectfully request the assistance of the Examiner to help him identify the specific paragraph numbers that do not correspond, and the amendments which were therefore not entered, so that appropriate action can be taken.

The specification stands objected to for failing to provide proper antecedent basis for claimed subject matter under 37 CFR 1.75(d)(1).

The drawings stand objected to for numbering informalities, and for failing to depict an inside edge shorter in length than the outside edge.

Claims 1-22 are pending. Claim 17 stands objected to for formal grammatical errors. Claims 1-22 stand rejected under 35 USC § 112, 2<sup>nd</sup>. Claims 8-12, 15, and 20-22 stand rejected under 35 USC § 102(e) as anticipated by Lambrecht (US 6,425,919). Claims 13, 14 and 16 stand rejected under 35 USC § 103(a) as being unpatentable over Lambrecht in view of Felt (USPAP 2001/0004710 A1). These rejections are respectfully traversed.

### Objection to the Specification under 37 CFR 1.75(d)(1)

The Examiner states that there is no antecedent basis in the specification for the recitation, ostensibly in claim 4, that the inside edge of the lateral extensions of the device of the claims be less than the outside edge. This objection is respectfully traversed. Further, as depicted in Figs. 3 and 10A, for example, the inside edge 24 is

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shown in illustrative fashion to be shorter in length than the outside edge 26, forming a trapezoid. It is respectfully submitted that the requirements of 37 CFR 1.75(d)(1) have been fully complied with and that the objection should be withdrawn.

Objection to the Drawings

The Examiner objected to Fig. 9 for erroneously depicting annulus 42 with numeral 40, and for including superfluous numeral 41. The present amendment corrects these problems as suggested by the Examiner, and it is respectfully requested that the objection be withdrawn.

The Examiner additionally objected to the drawings under 37 CFR 1.83(a) for failing to show the length of the insider edge of the lateral extensions as longer than the outside edge as called out in claim 4. Figs. 3 and 10A, for example, illustratively depicts the inside edge 24 as shorter in length than the outside edge 26, forming a trapezoid. It is respectfully submitted that the requirements of 37 CFR 1.83(a) have been fully complied with and that the objection should be withdrawn.

Rejection under 35 USC § 112, First Paragraph

The Examiner asserts that the specification, while being enabled for the device being a repair device, does not reasonably provide enablement for the device being a therapeutic or prophylactic device, as recited in claims 1-22.

Certainly, the therapeutic nature of the claimed device is well described, as recognized by the Examiner in stating that the repair functionality is enabled. To further this point, Applicant points to the following definition from the *Webster's Ninth New Collegiate Dictionary*:

**ther·a·peu·tic** 1: of or relating to the treatment of disease or disorders by remedial agents or methods.

Certainly, the specification clearly sets forth a device for treating a rent in the annulus fibrosus, and is therefore, for at least this reason, therapeutic. See, e.g., ¶¶ 010-014.

Further, Applicant points to the following definition from the *American Heritage College Dictionary*:

**pro·phy·lac·tic** acting to defend against or prevent something, esp. disease; protective.

Again, the specification clearly sets forth a device for preventing reherniation of nuclear material through a rent in the annulus fibrosus, and is therefore, for at least this reason prophylactic. See, e.g., ¶ 015.

There are other physiological reasons for the therapeutic and prophylactic nature of the device claimed, including scaffolding and reapproximating functions to mention only two, and therefore the above mentioned features are not exclusive.

Having shown that the specification adequately addresses both the therapeutic and prophylactic nature of the claimed device, it is therefore respectfully requested that the rejection under 35 USC § 112, ¶1 be withdrawn.

Rejection under 35 USC § 112, Second Paragraph

The Examiner points to various formal problems in claims 1, 11, 12, 13, 19 and 20.

Claim 1 has been amended to provide proper antecedent basis for the horizontal axis of the centralized vertical extension.

Claim 11 has been amended to depend from claim 9 as suggested by the Examiner, instead of claim 8, to provide proper antecedent basis for the recitation of "material." Claim 12 has also been amended to depend from claim 9 also to provide proper antecedent basis for the recitation of "material."

Claim 13 has been canceled so as to not duplicate claim 16.

Claim 19 has been amended to depend from claim 18 so as to not depend from itself.

Claim 20 has been amended to depend from claim 21 so as to not depend from a non-existent claim.

The Examiner is thanked for her helpful comments in addressing the rejections. It is respectfully submitted that all grounds for rejection have been redressed, and that the rejection should be withdrawn.

Rejection under 35 USC § 102(e)

Claims 8-12, 15, and 20-22 stand rejected under 35 USC § 102(e) as being anticipated by Lambrecht (US 6,425,919).

As a preliminary matter, it will be useful to sort out the priority of the claimed subject matter.

Applicant's invention claims benefit of priority to October 20, 1999. This application, a CIP, was filed on February 15, 2002. The subject matter added by this CIP corresponds to Figs. 13 through 23, and the accompanying text. Attached hereto as exhibit A is a redline document showing the material added to the parent application<sup>1</sup> in underline.

Lambrecht (US 6,425,919) bears a filing date of June 30, 2000, claiming priority to August 18, 1999, which is before Applicant's priority filing date, October 25, 1999 and December 21, 1999, both of which are after Applicant's priority filing date. It is pointed

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<sup>1</sup> The formal amendments made to the parent application by preliminary amendment are not depicted in order to more clearly display the CIP material; however, some highlighted material throughout the specification is underlined due to the word-processing compare function detecting a slight format difference in the compared text.

out here that the '919 patent specification is the result of a combination of three provisional applications and additional material added on the date of filing, which varied in scope and disclosure, and that only that material filed on August 18, 1999 should be considered as possibly being prior art against the Applicant's originally-filed subject matter. Attached hereto as exhibit B is Lambrecht's August 18, 1999 priority application (USPN 60/149,490).

The claim chart below depicts the priority of each feature of the independent claim (claim 21) for both Applicant and Lambrecht.

| Features of Independent Claim 21  | Applicant's Parent (10/20/99) <sup>2</sup>               | Lambrecht Provisional (8/18/99)              |
|---|--|--|
| A therapeutic or prophylactic device for treating a spinal disc annulus having an aperture, the device comprising   | Throughout, but see specifically see [044], [045], [046] | Throughout a therapeutic device is disclosed |
| a biocompatible material for placement in and across the aperture such that   | [044], [045]   | Not disclosed.                               |
| said material forms a bridge providing a platform for a traverse of fibroblasts or other normal cells of repair exiting in and around the various layers of the disc annulus. | [044], [045]   | Not disclosed.                               |

As can be appreciated from the above table, Applicant enjoys priority for each and every element of claim 21 back to his earliest priority date of October 20, 1999. Lambrecht does not enjoy any priority to this subject matter before Applicant's priority date.

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<sup>2</sup> References are to paragraph numbers in the attached Appendix A for the convenience of the Examiner.

The Examiner also states that the traverse of fibroblasts across an aperture in the annulus is inherent, but provides no indication as to why she believes such traversal would be inherent in the Lambrecht device as disclosed prior to October 20, 1999.

Accordingly, Lambrecht can not be relied upon to reject independent claim 21. Because claim 21 is the only independent claim, further treatment of the other limitations of the dependent claims is not necessary, but Applicant does notice that the Examiner points to many teachings and features that are not found in Lambrecht's August 1999 provisional application.

In light of the above, it is respectfully requested that the rejection be withdrawn.

Rejections under 35 USC § 103(a)

Claims 13, 14 and 16 are rejected as unpatentable for being obvious under Lambrecht '919 in view of Felt (USPAP 2001/0004710). As above, Lambrecht is not competent prior art as against independent claim 21 of the instant application. Felt does nothing to remedy this deficiency. It is therefore respectfully

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW  
GARRETT & DUNNER LLP

Dated: February 17, 2004

By: 

Eric P. Raciti  
Reg. No. 41,475

**Attachments:      Redline of Specification  
                             Copy of USPN 60/149490**

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